



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,851	04/02/2004	Naoyuki Kawanishi	Q80131	9464
23373 7590 10/14/2008				
SUGHRUE MION, PLLC				
2100 PENNSYLVANIA AVENUE, N.W.				
SUITE 800				
WASHINGTON, DC 20037				
EXAMINER				
CHEA, THORL				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
10/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,851

Applicant(s)

KAWANISHI ET AL.

Examiner

Thorl Chea

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/893,750.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/88)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is responsive to the communication on June 30, 2008; claims 23-42 are pending; claims 1-22 have been canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 40-42 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The apparatus disclosed in the specification disclosure such as shown in Fig. 3 contains tanks 29, 30, 38, 40 wherein the tank 29, and 30 contains reactants such as silver ion and alkali metal salt of an organic acid; the mixer 37, the storage tanks 38, 39 and ultrafiltration unit 42. Each component is interconnected such as pipelines to transfer the dispersion or solution. The specification disclosure fails to the use of pipelines such as being claimed in claims 40-41 to prepare the dispersion. The dispersion cannot be prepared through the pipeline. Each module needs to be interconnected. Moreover, the specification disclosure fails to describe "a pipeline for supplying a dispersion after ultrafiltration from a from a purification means". The system shown in Figs 1-3 discloses the ultrafiltration module (13), (26) and (42) connected to the storage tank. The scope of "purification means" encompasses the scope of "ultrafiltration module" disclosed in the specification disclosure. The ultrafiltration module should be connected to the

storage tank. The specification does not disclose the preparation of the dispersion using a mixing mean and purification means. There are no pipelines connected from the ultrafiltration module to mixing module.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 36-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawanashi et al (US 6,472,546)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

See Figs 2-3 on Sheet 2-3 of 4 of the '546 patent which discloses the apparatus as now being claimed. The invention lacks novelty.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 40-42 are rejected under 35 U.S.C. 103(a) as obvious over the combination of Kawanishi et al (US 6,472,546B1) and Kuno et al (US 6,630,293). The apparatus has a means of supplying silver ions, a means of supplying alkali of an organic acid, a reaction field solution, a closed mixing means connected by a pipeline. See Fig. 3 and Fig. 4 and the description thereof in column 6, lines 38-68 to column 7, and lines 1-5. Kuno et al discloses a desalt treatment of silver salt of an organic acid obtained by the reaction product of silver ion and alkali of an organic acid using ultrafiltration apparatus of Fig. 1. See column 48, lines 46-68 and Fig. 1. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to associate an ultrafiltration apparatus taught in Kuno et al in the system taught in Kawanishi et al to purify the obtained silver salt product, and thereby provide a device as claimed.

8. Claims 23-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kawanishi et al (US 6,472,546B1) and Kuno et al (US 6,630,293). Kawanishi et al discloses an apparatus for forming a silver salt of an organic acid substantially as claimed except failing to disclose a purification means. See apparatus of Kawanishi et al Fig. 2 to Fig. 4. Kuno et al discloses a desalt treatment of silver salt of an organic acid obtained by the reaction product of silver ion and alkali of an organic acid using ultrafiltration apparatus of Fig. 1. See column 48, lines 46-68 and Fig. 1. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to associate a ultrafiltration apparatus taught in Kuno

et al in the system taught in Kawanishi et al to purify the obtained silver salt product, and thereby provide a device as claimed.

Response to Arguments

9. Applicant's arguments filed June 30, 2008 have been fully considered but they are not persuasive. The rejection under 35 USC 103 over Kawanaishi et al is maintained due the statement of common ownership is not clear and concise. . The applicants should state in clear and conspicuous manner, that : "Application X and Patent A, at the time the invention of application X was made, owned by Company Z". A separate paragraph should be provided including the citation of the application and Patent No. The statement of common ownership fails to overcome the rejection under 35 USC 102(e) above.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T.C.?
October 9, 2008

/Thorl Chea/
Primary Examiner, Art Unit 1795